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PATENT
Customer No. 22,852
Attorney Docket No. 02481.1751

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Cordula HOPMANN, et al.) Group Art Unit: 1623
Application No.: 09/966,109) Examiner: Elli Peselev
Filed: October 1, 2001)
For: CITRULLIMYCINES, A PROCESS)
FOR THEIR PRODUCTION AND)
THEIR USE AS)
PHARMACEUTICALS)

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Assistant Commissioner for Patents
Washington, DC 20231

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

In response to the Office Action dated December 6, 2002, (Office Action), Applicants respectfully request reconsideration of this application in view of the following remarks. Claims 1-22 are pending in this application. In the Office Action, the Office required restriction under 35 U.S.C. § 121 between the following groups of claims:

Group I: Claims 1-15 and 18-21, drawn to citrullimycines; and

Group II: Claims 16-17 and 22, drawn to a fermentation process for preparing citrullimycines.

The Restriction Requirement is respectfully traversed. However, to be fully responsive, Applicants provisionally elect, with traverse, the subject matter of Group I, claims 1-15 and 18-21.

In the Office Action, the Office failed to indicate the reason why the joint examination of claims from Groups I and II would be a serious burden, other than to mention that the inventions are distinct. The Office's attention is respectfully directed to M.P.E.P. § 803, which sets forth criteria and guidelines for the Office to follow in making a proper requirement for restriction. The M.P.E.P. instructs the Office as follows:

If the search and examination of an entire application can be made without **serious** burden, the Office must examine it on the merits, **even though it includes claims to distinct or independent inventions.** M.P.E.P. § 803 (emphasis added).

Applicants traverse the restriction requirement on the grounds that the Examiner has not shown that there would be a **serious** burden to examine Groups I and II together, despite the statement that a prior art search of these groups includes different areas of classification. Applicants submit that a joint search of Groups I and II would not be burdensome because claims 16 and 17 (part of Group II) depend from claim 1 (part of Group I) and therefore contain subject matter whose proper search would overlap with the search of Group I. Accordingly, Applicants respectfully request that, at the minimum, claims 1-15 and 18-21 (the claims of Group I) and claims 16 and 17 be examined together. Similarly, claim 22 is drawn to a microorganism mentioned in the claims of Group I and, therefore, also contains subject matter whose search would overlap with a proper search of the claims of Group I. Accordingly, Applicants respectfully request that the Office examine all pending claims in this application together.

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Because the Office has not established that the joint examination of claims from Groups I and II would be a serious burden, Applicants submit that the Office has not established a *prima facie* case of serious burden of search. Therefore, Applicants respectfully request that the restriction requirement be withdrawn.

Furthermore, Applicants respectfully remind the Office that in view of the court findings in *In Re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996), claims directed to processes of making or using a compound are subject to rejoinder with claims drawn to that compound once the compound is found patentable. See also M.P.E.P. §§ 821.04 and 2116.01.

Pursuant to the above-referenced rejoinder procedure, Applicants respectfully request that at least claims 1-21 be examined together in this application.

Should the Office consider that a telephone conference with Applicants' representative would expedite prosecution of this application, the Office is encouraged to contact the undersigned at (202) 408-4123.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By:

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Dated: January 2, 2003